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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/739,023	12/08/2000	Andrea Michalik	2384-002133	4154

7590

04/05/2005

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EXAMINER

HAAS, WENDY C

ART UNIT	PAPER NUMBER
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1661

DATE MAILED: 04/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<p align="center"><b>Office Action Summary</b></p>	<p><b>Application No.</b></p> <p>09/739,023</p>	<p><b>Applicant(s)</b></p> <p>MICHALIK, ANDREA</p>	
	<p><b>Examiner</b></p> <p>Wendy C Haas</p>	<p><b>Art Unit</b></p> <p>1661</p>	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 September 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 1/5/4 & 8/13/1 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)          |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. <u>1/4/5</u>   |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

Art Unit: 1661

**DETAILED ACTION**

**The previous Office Action mailed November 24, 2004 is hereby vacated. An Action on the case follows.**

**35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 remains rejected under 35 U.S.C. 102(b) as being anticipated by CPVO

Breeder's Right grant number **7048** in view of applicant's admission of October 2, 2003 that the claimed plant was first offered for sale March 1, 1999, for reasons of record.

**CONCLUSION**

No claim is allowed.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

Art Unit: 1661

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

### COMMENTS

Applicant argues in response to the prior Office Action that the references cited are non-enabling publications and there is no information of record regarding the foreign availability or reproducibility of the claimed plant.

The Examiner believes the cited references are enabling publications under the decision in Elsner, as the CAFC held that “published applications, combined with the foreign sales of the plants, placed the claimed inventions in the possession of the public . . . they are proper § 102(b) anticipatory references that may bar patentability.” In re Elsner, 381 F.3d 1125, 1129 (Fed. Cir. 2004).

Should applicant elect to appeal the rejection of record, the following information may prove useful:

Under Elsner, the Office must show the following facts and/or evidence in order to establish a *prima facie* case of unpatentability under 35 U.S.C. § 102(b) based on a publication disclosing the claimed plant made more than one year prior to the filing date of application for patent in the United States:

1. A publication disclosing the claimed plant published more than one year prior to the effective filing date of the United States application for patent. Elsner, 381 F.3d at 1129;

Art Unit: 1661

2. Public possession of the claimed plant more than one year prior to the effective filing date of the United States application for patent. Id. at 1130. Public possession is defined as “availability known in the art” rather than “an obscure, solitary occurrence.” Id. at 1131;
3. Reproducibility of the claimed plant by a person of ordinary skill in the art without undue experimentation. Id.

The rejection of record meets the criteria set forth in Elsner in the following ways:

1. CPVO Breeder’s right grant number 7048 was published more than one year prior to the effective filing date of the instant application for patent. The breeder’s right grant lists the breeder’s name as “ELSNER PAC JUNGPFANZEN”. The Examiner’s Internet search for “ELSNER PAC JUNGPFANZEN” revealed as the first search result the breeder’s web site: <http://www.pac-elsner.com/>.
2. Applicants’ admission of October 2, 2003 stated that the claimed plant was first offered for sale March 1, 1999, more than one year prior to the effective filing date of the instant application for patent. Since Applicants are in the business of selling plants, it is assumed that this sale constitutes “availability known in the art” rather than “an obscure, solitary occurrence.” Applicants are invited to provide further information regarding sale(s) of the claimed plant during the critical time period. Evidence that availability of the claimed plant more than one year prior to the effective filing date of the instant application for patent

Art Unit: 1661

would not constitute "availability known in the art" may be sufficient to overcome the rejection of record.

3. Applicants' Specification notes that the claimed plant was asexually reproduced by "cuttings", a common method known in the art, as early as 1995 [Page 1, line 11.]

#### **FUTURE CORRESPONDENCE**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wendy C. Haas whose telephone number is (571) 272-0976. The examiner can normally be reached on Monday through Friday 7:00 to 3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang can be reached on (571) 272-0811. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

W. C. Haas

KENT BELL  
PRIMARY EXAMINER

